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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,139	02/02/2004	John P. Downs	5398-CIP-CON-3	9662
22922	7590	12/08/2005	EXAMINER	
REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA KASULKE, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202			AHMAD, NASSER	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 12/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/770,139

Applicant(s)

DOWNS, JOHN P.

Examiner

Nasser Ahmad

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-16,18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-16,18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/24/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 24, 2005 has been entered.

Rejections Withdrawn

2. Claims 1, 3-4, 6-7, 9-11, 14-16 and 18-22 rejected under 35 USC 102(b) as being anticipated by Torrey made in the last Office action of May 23, 2005 has been withdrawn in view of the amendment filed on October 24, 2005.
3. Claims 1, 3-7, 9-16 and 18-22 rejected under 35 USC 103(a) as being unpatentable over Torrey has been withdrawn in view of the amendment.

Response to Arguments

4. Applicant's arguments with respect to claims 1, 3-7, 9-16, 18 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-4, 6-7, 9-11 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Torrey (3741786).

Torrey relates to an adhesive dispensing tape (10) comprising a flexible carrier tape (12), a row of adhesive segments (14) spaced apart along the longitudinal length of the tape, each segments being disposed between the two side edges, and can be transferred by flexing the tape. The adhesive is pressure sensitive adhesive (PSA) (col. 3, line 30) and applied to the carrier in a hot melt form, hence it include hot melt adhesive. The carrier tape is provided with first and second release surfaces such that the adhesive segments adhere less strongly to the second release surface when unwound from a roll (col. 2, lines 8-12 and col. 3, lines 5-12). The adhesive segments are centered along the transverse width of the tape to form a longitudinally straight line and a single row as shown in figure-4. The segments can be of any shape such as dots, bars, star, triangle, etc. or any pattern without any criticality (col. 3, lines 57-68). The dot shape would exhibit circular configuration. Figures 3-4 shows that the adhesive

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segments are in a single row. The transverse position of each segment is distinct as shown by their separate position along the tape length.

The intended use phrases such as “whereby”, “may be transversely flexed”, “exposable”, etc. have not been given any patentable weight because said phrases are not found to be of positive limitations.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-7, 9-16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torrey.

Torrey, as discussed above, fails to teach expressly that the segments are disc shaped. However, Torrey clearly discusses that the shape of the adhesive segments are not critical and it can have any desired shape. Thus, it would have been obvious to one having ordinary skill in the art to modify Torrey by providing its adhesive segments in a disc shape, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ47 (CCPA 1976).

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As for the two adjoining segments of the tape, it would have been obvious to one having ordinary skill in the art to modify Torrey by providing a plurality of adjoining segments by cutting a wider carrier tape into longitudinal segments for manufacturing economics, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

11. Applicant's arguments filed October 24, 2005 have been fully considered but they are not persuasive.

Applicant argues that Torrey fails to disclose that each adhesive segment is located in a different transverse position. This is not deemed to be convincing because Torrey shows, in figures 3 and 4, that the adhesive PSA segments are spaced apart from each other. Figure 4 also shows the presence of a single row of adhesive segment with one adhesive positioned transversely. Since, in col. 3, lines 66-68, Torrey states that the pattern of the adhesive segments are not critical, any pattern would have been obvious matter of design choice. Further, contrary to applicant's position, the claims are not directed to the segments having different transverse position as alleged, rather the claims merely recite that the transverse dimension of the segments are distinct. Thus, claims 1, 7 and 16 are clearly anticipated by Torrey.

As for the segments containing the same number of adhesive segment disposed therein (claim 16), Torrey's figure-4 shows that the adhesive segments are spaced apart and

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the segment can be defined to include two of said adhesive segments in each of the tape segments.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record discussed above.

Query

12. Applicant is requested to indicated where the support is in the specification for the segments being distinct. In the case, where the segments are indeed distinct, then applicant should also show its support in the parent application in order for the instant application to be a continuation thereof. Otherwise the application should be a continuation-in-part of the parent.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1, 3-7, 9-16, 18 and 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-4 of U.S. Patent No. 6640864. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the patents are directed to a thermoplastic adhesive dispensing tape comprising a plurality of adhesive dots arranged on a flexible carrier tape.

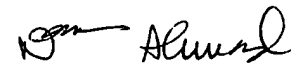
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad 11/27/05
Primary Examiner
Art Unit 1772

N. Ahmad.
November 27, 2005.